

REMARKS

Responsive to the non-final office action mailed July 5, 2006, please consider the following remarks.

Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 were elected without traverse and are pending the application. Claims 4-6, 9-12, 14, 16, 18, 20-151, 153-179, 183-185, 188-191, 193, 195, 197, 199-330, and 332-432 were withdrawn from consideration. Claims 1 and 180 have been amended. No new matter has been added.

I. Claim Rejections under 35 U.S.C. § 112

Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 are currently rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In an effort to expedite prosecution, Applicants have amended independent claims 1 and 180 to recite “where the at least one communication device initiates at least one action having the effect of providing a change of one or more of resource-consumption and resource-production.” Applicants believe this amendment addresses the Office Action’s request for clarification.

With regards to the “wherein” clause, Applicants respectfully submit that the claims do not include language that suggests or makes optional but rather positively recites features that limit the scope of a claim or claim limitation. MPEP 2106(C) cautions that “wherein” clauses *may* raise a question to the limiting effect, but does not necessarily warrant a rejection under 35 U.S.C. § 112 in all circumstances. Applicants respectfully submit that the claims particularly

point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants respectfully request clarification from the Examiner as to what claim limitations fail to meet this requirement.

II. Claim Rejections under 35 U.S.C. § 103

A. Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 are Patentable over Brown in view of Woolard

Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown, U.S. Patent 5,544,036 (“Brown”) in view of Woolard, *et al.*, US Patent 6, 78,362 (“Woolard”).

Brown purports to disclose an energy management and home automation system including controllers in each facility and one or more energy consuming devices attached to each controller. According to Brown, each controller responds to digital paging signals from a central command center which establish a schedule of event effecting the operation of each device and the controller schedules each device to be operated pursuant to the programmed schedule. The user of the system may cause a paging message to be provided at anytime changing the pre-programmed schedule. *See Brown Abstract.*

Woolard, on the other hand, purports to disclose an energy management system for providing energy users with a comprehensive understanding of the energy consumption of their physical plant. The Woolard system includes a real-time data retrieval and dissemination process and system which permits real-time energy data to be communicated within the system. *See Woolard Abstract.* The real-time server of Woolard allows multiple users from a variety of locations to access important energy information at a much lower cost. *See Woolard, column 2, lines 15-19.*

The Office Action summarily concludes that it would have been obvious to combine the disclosures of Brown and Woolard because “it would advantageously allow to implement said system for multi-building facility, and interconnect various equipment for purposes of control and managing.” *See* page 4, Office Action mailed July 5, 2006. The Office Action has failed to provide a proper statement of motivation for combining the two disparate references. Instead, the alleged statements of motivation are based on improper hindsight.

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action’s justification for combining Brown and Woolard has absolutely nothing to do with the admitted deficiencies of Brown. As admitted by the Office Action, Brown fails to show at least “said central computer includes a server.” *See* page 4, Office Action mailed July 5, 2006. To properly modify Brown to correct for these deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Brown. The server of Woolard allows users to access information (column 2, lines 15-19) but fails to teach one of ordinary skill in the art to modify the system of Brown to include a central server for “generating at least one informational message ... related to one or more of resource-consumption by, resource-production by and

control of at least one device” and further “transmitting the at least one informational message to at least one communication device, where the at least one communication device initiates at least one action having the effect of providing a change of one or more of resource-consumption and resource-production attributed to the at least one device of one or more devices.” Any such motivation is completely lacking.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Brown as taught by Woolard, so the proposed modification fails. In fact, Brown and Woolard are improperly combined and lack proper motivation. Even if the combination of Brown and Woolard could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Applicants.

A proper obviousness rejection requires a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P. § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Accordingly, the Office Action fails to establish a *prima facie* case of obviousness for at least failing to present a motivation to combine the cited references. Further, assuming *arguendo* that the references may be combined and a reasonable expectation of success, the combined references do not disclose or suggest all of the claim limitations.

B. Neither Brown nor Woolard disclose “receiving at least one command” as recited by Claims 3 and 182.

Dependent claim 3 recites “receiving at least one command at the central server, wherein the at least one command is related to controlling at least one device and wherein the at least one

informational message is generated based on the at least one command.” Dependent claim 182 recites a similar limitation. Recognizing the deficiencies in Brown, the Office Action relies on Woolard to meet this admittedly missing limitation by turning to column 5, lines 47-51 of Woolard. Nothing in this highlighted section or the entire disclosure of Woolard meets the limitations of claim 3 and 182. Woolard purports to disclose the ability to diagnose energy usage problems and develop strategies to reduce energy costs by optimizing responses to queries by the user based on the time of day, the current energy rate and environmental conditions. However, the Office Action has failed to show how this disclosure meets the limitation of “receiving at least one command at the central server” and further where “the at least one command is related to controlling at least one device and wherein the at least one informational message is generated based on the at least one command.” These claim features are simply missing from the disclosure of Woolard.

Further, there is no motivation available to one of ordinary skill in the art to modify the system of Brown, which admittedly does not include a “central server” to further receive at least one command and generate the informational message based on the at least one command.

C. Neither Brown nor Woolard disclose “a user profile” as recited by Claims 13, 14, 152, 192, 194 and 331.

Dependent claim 13 recites “wherein the at least one command is generated in accordance with a user profile.” Dependent claim 192 recites a similar limitation. Dependent claims 14 and 194 depend on claims 13 and 192, respectively. Dependent claim 152 recites that “wherein the at least one command is from a user associated with the at least one device, the user having an associated user profile.” Dependent claim 331 recites a similar limitation.

Recognizing the deficiencies in Brown, the Office Action relies on Woolard to meet this admittedly missing limitation by turning to column 6, lines 49-54 of Woolard. Nothing in this

highlighted section or the entire disclosure of Woolard meets the limitations of claim 13, 14, 152, 192, 194 and 331. Woolard purports to disclose the user to customize, create or update a particular site to add various information. However, the Office Action has failed to show how this disclosure meets the limitation of “a user profile” and further where “the at least one command is generated in accordance with a user profile.” The disclosure relied upon by the Office Action for meeting the “at least one command” limitation and the “user profile” limitation are unrelated. Therefore, it is clear that Woolard fails to show “wherein the at least one command is generated in accordance with a user profile.” The claim limitations directed to a user profile are simply missing from the disclosure of Woolard.

Further, there is no motivation available to one of ordinary skill in the art to modify the system of Brown, which admittedly does not include a “central server” to further receive at least one command and generate the informational message based on the at least one command, and further generate the at least one command in accordance with a user profile.

CONCLUSION


In view of the foregoing amendments and arguments, it is respectfully submitted that this application is in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no additional fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:



Yisun Song
Registration No 44,487 for
Brian M. Buroker
Registration No. 39,125

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Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)